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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/964,989 | 09/26/2001 | Roland N. Walker | 10414.4 | 2969 |
| 21999 | 7590 | 03/11/2004 | EXAMINER | |
| KIRTON AND MCCONKIE 1800 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE P O BOX 45120 SALT LAKE CITY, UT 84145-0120 | | | BAHTA, ABRAHAM | |
| ART UNIT | | PAPER NUMBER | | 1775 |
| DATE MAILED: 03/11/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|-------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/964,989 | WALKER, ROLAND N. |
| Examiner | Art Unit | |
| Abraham Bahta | 1775 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 06 October 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-34 is/are pending in the application.

4a) Of the above claim(s) 1-10 and 16-20 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11-15 and 21-34 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). 9.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) Other:

DETAILED ACTION

Claims 1-34 are pending in this application. Claims 1-10 and 16-20 are withdrawn from further consideration as being drawn to a non-elected invention.

The amendment filed 10/06/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the limitation such that "the image being identical" and "each of the group of flowers in free of indentations and surface cellular damage" as recited in the claims is new matter. There is no previous mention of the "image being identical" or the flowers being "free of indentations and surface cellular damage".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-15, 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al (USP 6,172,328) or Skonecki (USP 5,305,550).

Jones teaches an organic product such as a leaf/ flower petals which may be in a natural configuration (see Fig. 1 and col. 3, lines 43-45) in which the organic product may be marked/etched with a device/laser/galvanometer. The marking may be a

message of greeting, expression, identification, information, communication, inscription and advertisement. See col. 1, lines 54-65; col. 3, lines 21-49 and col. 4, lines 21-27.

Skonecki teaches an organic product such as fresh natural flower, such as a rose in a natural configuration in which the product is provided with a personalized message or drawing inscribed on one of its petals. See col. 1, lines 24-38.

Jones and Skonecki do not require identical images on a number of flowers; however, Jones and Skonecki teach the concept of providing an image, drawing or personalized message on the flower petal or rose. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided identical images on a group of flowers in order to promote the sales of the flowers. The limitation such that the image is "pad-printed" has been considered; however, when there is a substantial similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct over the product of the prior art. See *In re Brown*, 173 USPQ 685, and *In re Fessmann*, 180 USPQ 324.

Regarding the limitation such that the "image being printed", Webster's II New Riverside University Dictionary defines the word "print" as a device or implement as a stamp, die, or seal, for pressing markings on or into a surface. Thus, the limitation of the claim is met by the disclosure.

Regarding claim 15, patentability of product-by-process claims are based on the product itself even though such claims are limited and defined by the process. Thus,

the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Claim Rejections - 35 USC § 103

Claim 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones '328 or Skonecki '550.

As discussed above, Jones and Skonecki teach applicant's claimed invention except fails to mention the petal being detached from the flower; however, Jones teaches a flower/petal may be marked/etched with a device and Skonekci teaches a flower/petal/rose which may be inscribed on its surface with a personalized message. It would have been obvious to one of ordinary skill in the art to mark/print only the petal portion of a flower so that only the petal may be attached to a greeting card for easy shipment or to attaché the petal on other objects such as refrigerator, book or wall for aesthetic reasons.

Regarding claim 25, Jones teaches applicant's claimed invention except fails to mention the flower is a rose; however, it is the Examiner position that since Jones indicates that a flower petal or leaves may be marked with a device the skilled artisan would find it obvious to use a rose or a petal because a petal is the colored segment of an outer envelope of a flower composed of fused or separate petals and a rose is a flower according to Webster's II New Riverside University Dictionary. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide an image or a mark on a rose or a petal because petals, flowers, leaves or

roses may be used interchangeably. In addition, Skonecki teaches a rose may be inscribed with a personalized message.

Regarding claims 26, 28-30, Jones teaches the ornament design or marking formed on the flower/petal may be a message, greeting, expression, identification, information, communication, inscription, advertisement, bar code, inventory marking price information or business message. See col. 3, lines 21-38. In addition, Skonecki teaches the inscription may be personalized message such as the word "congratulations".

Regarding claim 27, patentability of product-by-process claims is based on the product itself even though such claims are limited and defined by the process. Thus, the product is unpatentable if it is the same as or obvious from the product of the prior art even if the prior product was made by a different process.

Response to applicant's arguments

The applicant contends that the rose of the present claimed invention is "free of indentations and surface cellular damage" whereas the rose of Skonecki '550 is indented, causing surface cellular damage and faster withering. The Examiner disagrees. Skonecki at col. 2, lines 19-24 teaches when the Pilot pen is used to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and that no smearing, smudging or other unwanted marks are left on the petal surface.

With respect to Jones, the applicant argues that the reference teaches methods for etching, cutting the surface of a flower, plant cut foliage and that the process Jones

does not teach overlaying an image onto a group of flowers in a natural configuration.

The Examiner disagrees. Jones teaches the leaves may be provided with a design by inserting an opaque metal stencil machined with the desired design and focusing optics between a stationary laser beam and foliage and that the leaves may be used in floral arrangement or potted plant arrangements to convey a greeting such as "Happy valentines Day". Jones teaches the designs may be provided using stencils. See col. 1, lines 54-65 and col. 4, lines 26-27. Further, Jones's flower/petal/leaf is natural because Jones is concerned regarding the ability of the leaf to photosynthesize and respire even when the design is provided on the surface of the flower. See col. 3, lines 38-44.

The applicant further argues that the cited reference fail to teach or suggest using a device to overlay an image onto a flower. The Examiner contends that the references discussed above teach that a surface of a flower/petal/rose which is provided with an image or design or personalized message. The limitation such that the image is "pad-printed" has been considered; however, when there is a substantial similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct over the product of the prior art. See *In re Brown*, 173 USPQ 685, and *In re Fessmann*, 180 USPQ 324. Regarding the limitations that the flower is free of indentions and surface cellular damage, both Jones and Skonecki teach the design is provided to the surface of the leaf or flower without destroying the leaf. See Jones col. 3, line 39 through 4, line 14 and Koneke col. 2, lines 19-24.

With respect to Skonecki, the applicant argues that using a pointed pen places a variable amount of pressure on the flower causing indentations and cellular damage. The Examiner contends that although Skonecki uses a pen to write on the surface of the petal, a fine line of paint is applied which dries almost instantly upon contact with the surface of the petal and as a result, no smearing, smudging or other unwanted marks are left on the petal surface. See Skonecki col. 2, lines 19-24.

Applicant's remarks regarding commercial success and licensing have been considered; however, it is the Examiner's position that the claims are obvious in view of the references cited.

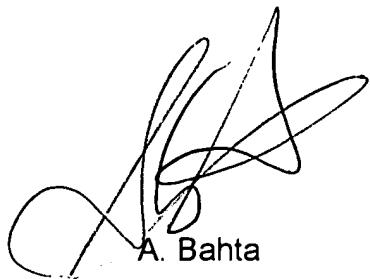
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Abraham Bahta whose telephone number is (571) 272-1532. The Examiner can normally be reached Monday-Friday from 11:30 AM -8:00 PM (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. Bahta

03/04/04



DEBORAH JONES
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